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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/680,923	10/06/2000	Steven Bechhofer	40108/00101	3044
30636	7590	06/28/2005	EXAMINER	
FAY KAPLUN & MARCIN, LLP 150 BROADWAY, SUITE 702 NEW YORK, NY 10038			MEINECKE DIAZ, SUSANNA M	
		ART UNIT		PAPER NUMBER
				3623

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/680,923	BECHHOFER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Susanna M. Diaz	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 08 April 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 2-20 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 2-20 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
     Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 8, 2005 has been entered.

Claims 2-14 and 16 have been amended.

Claims 17-20 have been added.

Claims 2-20 are pending.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 2-20 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 2-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 2-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification and drawings, as originally filed, do not include any mention of the use of software or a computer. The only originally filed disclosure regarding the use of software is found in original claims 10-15. Applicant has recently amended claims 2-9 to specify that the recited steps are performed by software; however, this subject matter is not supported by Applicant's original disclosure. For example, the limitations introduced in claims 3 and 5-9 were never previously disclosed as performed by software. Regarding claim 2, while original claim 11 recites a calculation module that "projects a value for the future condition of the business entity based on a multiplication...", claim 2 recites that a "*monetary* value is determined by a multiplication..." It is not clear that the value of claim 11 is necessarily a *monetary* value. Similarly, regarding claim 4, original claim 13 recites "a handling module suggesting risk handling measures..."; however, this does not fully support the software-implementation of actually "handling at least one of the risks..." and "handling at least one of the opportunities to increase the probability that the at least one

opportunity will occur," as recited in claim 4. Therefore, claims 2-9 are rejected as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claims 10-14 have been amended to recite various "means" instead of the previously recited "modules." The specification does not clarify which structure, if any, is associated with the recited means; therefore, claims 10-14 are not adequately described in the specification and are rejected as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Independent claims 10, 15, and 17 recite that, for each risk, a probability that the risk will occur during a predetermined period of time or a frequency at which the risk will occur is determined. Similarly, for each opportunity, a probability that the opportunity will occur during a predetermined period of time or a frequency at which the opportunity will occur is determined. Then, a "monetary value for each of the risks and opportunities is determined based on the potential monetary impact and the corresponding one of frequency and probability"; however, if the risk is based on a probability that the risk will occur during a predetermined period of time and the opportunity is based on a frequency at which the opportunity will occur (or vice-versa), then what meaningful analysis is generated based on making such an "apples-and-oranges" comparison (i.e., making a comparison between probability versus frequency

of two different factors)? The Examiner has looked toward the specification for clarification. The specification either compares both risk and opportunity in light of a probability that each will respectively occur during a predetermined period of time or there is a separate comparison of both risk and opportunity in light of a frequency at which each will respectively occur. Additional confusion is raised in the dependent claims, especially those that specifically recite more details about the probability versus frequency analysis without clarifying how both analyses can be interrelated. Since the specification fails to provide sufficient adequate written disclosure to answer these questions, claims 2-20 are rejected as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Furthermore, undue experimentation would be required by one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, as intended by Applicant.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 2-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In light of the rejection of claims 10-14 under 35 U.S.C. § 112, 1<sup>st</sup> paragraph (for failure to support the recitation of the various means), the scope of the recited means is ambiguous, thereby rendering claims 10-14 vague and indefinite.

Independent claims 10, 15, and 17 recite that, for each risk, a probability that the risk will occur during a predetermined period of time or a frequency at which the risk will occur is determined. Similarly, for each opportunity, a probability that the opportunity will occur during a predetermined period of time or a frequency at which the opportunity will occur is determined. Then, a “monetary value for each of the risks and opportunities is determined based on the potential monetary impact and the corresponding one of frequency and probability”; however, if the risk is based on a probability that the risk will occur during a predetermined period of time and the opportunity is based on a frequency at which the opportunity will occur (or vice-versa), then what meaningful analysis is generated based on making such an “apples-and-oranges” comparison (i.e., making a comparison between probability versus frequency of two different factors)? The Examiner has looked toward the specification for clarification. The specification either compares both risk and opportunity in light of a probability that each will respectively occur during a predetermined period of time or there is a separate comparison of both risk and opportunity in light of a frequency at which each will respectively occur. Additional confusion is raised in the dependent claims, especially those that specifically recite more details about the probability versus frequency analysis without clarifying how both analyses can be interrelated.

Claims 2-9, 11-14, 16, and 18-20 are dependent from claims 10, 15, and 17 and therefore inherit the same rejection under § 112.

Appropriate correction and/or clarification is required.

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 10-14 and 17-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the “progress of science and the useful arts” (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

Claims 10-14 are directed toward a system comprising means that are unsupported by the specification (as discussed in the rejection under 35 U.S.C. § 112,

1<sup>st</sup> and 2<sup>nd</sup> paragraphs, above). Until the corresponding structure is clarified, the recited means will be interpreted as software *per se*, which is deemed to be non-statutory.

As per claims 17-20, the recitation of “a computer implemented method” is limited to the preamble in claims 17-20. This limitation does not breathe life into the body of the claims. Furthermore, depending on the extent of computer implementation, such a recitation might amount to a mere nominal incorporation of technology, which is not sufficient to overcome the rejection under 35 U.S.C. § 101. While claims 17-20 recite the useful, concrete, and tangible result of projecting a condition of a business entity, they are deemed to be non-statutory for failure to apply, involve, use, or advance the technological arts.

Appropriate correction is required.

Because claims 2-20 are so indefinite, no art rejection is warranted as substantial guesswork would be involved in determining the scope and content of these claims.

See *In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962); *Ex parte Brummer*, 12 USPQ 2d, 1653, 1655 (*BdPatApp&Int* 1989); and also *In re Wilson*, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). Prior art pertinent to the disclosed invention is nevertheless cited and applicants are reminded they must consider all cited art under Rule 111(c) when amending the claims to conform with 35 U.S.C. 112.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Daniell ("Strategy and Volatility: Risk and Global Strategic Challenge") -- Discloses an approach to assessing the relationships among risks and opportunities in the telecommunications industry.

10. This Office action has an attached requirement for information under 37 C.F.R. § 1.105. A complete response to this Office action must include a complete response to the attached requirement for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 10 am - 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Susanna Diaz*  
Susanna M. Diaz  
Primary Examiner  
Art Unit 3623

June 23, 2005

***37 CFR § 1.105 - Requirement for Information***

1. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

The information is required to extend the domain of search for prior art. Limited amounts of art related to the claimed subject matter are available within the Office, and are generally found in class 705 and subclass 7, which describes general management of an organization. A broader range of art to search is necessary to establish the level of knowledge of those of ordinary skill in the claimed subject matter art of risk-opportunity analysis. The Examiner is especially interested in background regarding the calculations (i.e., determinations) and comparisons thereof used in the claimed invention, such as those recited in claims 2, 8, 9, 11, and 18. Did Applicant invent these calculations (i.e., determinations) and comparisons thereof or are they well-known in the prior art?

2. The fee and certification requirements of 37 C.F.R. § 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 C.F.R. § 1.105 that are included in the applicant's first complete communication responding to this requirement.

3. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement

under 37 C.F.R. § 1.105 are subject to the fee and certification requirements of 37 C.F.R. § 1.97.

4. The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete response to the requirement for that item.

5. This requirement is an attachment of the enclosed Office action. A complete response to the enclosed Office action must include a complete response to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action, which is three (3) months.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 10 am - 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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June 23, 2005



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